

REMARKS

Favorable reconsideration of the above-identified application, as presently amended, is respectfully requested. Claims 1-3, 6-8, 13, 18, 20, and 27 have been amended to replace the term "reading device" with the term "electronic pen." These claim amendments have been made to clarify the subject matter claimed. It is believed that these amendments do not necessitate further searching by the Examiner. Claims 1-3, 5-8, 13-20, and 26-31 remain pending in the present application.

Claims 1-3, 5-6, 13-16, 18-19, and 26-27 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,396,481 to Challa ("Challa"). Claims 7-8, 17, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Challa in view of U.S. Patent 5,739,810 to Merkel ("Merkel"); Claims 30-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Challa in view of U.S. Patent 6,118,436 to Kushita ("Kushita").

Claims 1-3, 5-6, 13-16, 18-19, and 26-27 stand rejected under 35 U.S.C. §102(a) as being anticipated by Challa. Claim 1, as amended, includes the feature of "an electronic pen for detecting a portion of the predefined address pattern adjacent to the electronic pen." Claim 18, as amended, includes the feature of "detecting at least one position, using an electronic pen". The electronic pen detects a portion of the address pattern of the specially formatted surface. The specially formatted surface does not detect any information related to the position or strokes of the electronic pen. In contrast, as noted above, Challa detects the position of the stylus or pen by information detected by the ink capture device (i.e., the pad the pen writes on). See Challa col. 5, lines 20-22. The ink capture device then transmits the information to the image capture device for further processing. See Challa col. 6, lines 18-27.

The ink capture device of Challa requires complex processing operations and sensing technology, whereas the specially formatted surface of claims 1 and 18 of the present invention does not. Applicants respectfully submit that Challa does not teach or suggest an "electronic pen for detecting a portion of the predefined address pattern adjacent to the electronic pen" as claimed in claims 1 and 18. Applicants respectfully request that the §102 rejection be withdrawn.

Claims 2, 3, 5-6, 13-16, 18-19, and 26-27 are deemed to distinguish over Challa for at least the same reasons as stated above. Furthermore, claim 13 includes the feature of "the electronic pen includes a transmitter for communicating with the electronic device." Figure 3, element 242 of Challa shows a transmitter of the digitizer, which is related to the ink capture device, *not* the pen. Therefore, for this additional reason, claim 13 is not taught or suggested by Challa. Claim 14 is directly dependent from claim 13, and therefore is not taught or suggested for at least the same reasons as stated above with respect to claims 1 and 13.

Claim 27 includes the feature of a "selection is detected by sensing a pressure on the electronic pen." The passage cited in the Office Action (col. 4, lines 3-11 and col. 5, lines 13-42) relates to pressure-sensing technology of a digitizer. The digitizer is related to the ink capture device and senses pressure on the ink capture device, instead of the pressure on the pen. Therefore, for this additional reason, claim 27 is not taught or suggested by Challa. As such, Applicants respectfully request that the §102 rejection of claims 1-3, 5-6, 13-16, 18-19, and 26-27 be withdrawn.

Claims 7-8, 17, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Challa in view of Merkel. Claims 7-8, 17, and 20 are either directly or indirectly dependent on claim 1 or 18

respectively, and are therefore not taught or suggested by Challa for at least the same reasons as stated above. Moreover, Merkel does not remedy the deficiencies of Challa in that Merkel also does not teach an electronic pen for detecting a portion of the predefined address pattern as claimed in claims 1 and 18. Merkel is cited at page 5 of the Office Action for the purpose of teaching "the displaying includes a cursor, wherein the position of the reading device with respect to the navigation field controls the position of the cursor on the display screen" and "wherein a current position of the cursor is performed by a selection function". As such, the combination of Challa and Merkel does not teach, suggest, or render obvious the present invention as claimed in claims 7-8, 17, and 20. Applicants respectfully request the §103 rejection of claims 7-8, 17, and 20 be withdrawn:

Claims 30-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Challa in view of Kushita. Claims 30-31 are directly dependent on claim 18 and are therefore not taught or suggested by Challa for at least the same reasons as stated above. Moreover, Kushita does not remedy the deficiencies of Challa in that Kushita also does not teach an electronic pen for detecting a portion of the predefined address pattern as claimed in claims 1 and 18. Kushita is merely cited at page 6, item 3. of the Office Action for the purpose of teaching "translating the at least one detected portion of the address pattern into a rotation angle or a tilt angle." As such, the combination of Challa and Kushita does not teach, suggest, or render obvious the present invention as claimed in claims 30-31. Applicants respectfully request the §103 rejection of claims 30-31 be withdrawn.

It is believed that entry of this Amendment is warranted under the provisions of 37 C.F.R. § 1.116 as it clearly causes the claims active in this application to be allowable over the art of record. Accordingly,

it is believed that entry of this Amendment is warranted under the provisions of 37 C.F.R. § 1.116.

In view of the foregoing, Applicant respectfully requests the thorough reconsideration of this application and earnestly solicits an early notice of allowance.

Respectfully submitted,

JENKENS & GILCHRIST,  
A Professional Corporation



Ashley N. (Farris) Moore  
Reg. No. 51,667

1445 Ross Avenue, Suite 3200  
Dallas, Texas 75202-2799  
(214) 965-7393  
(214) 855-4300 (fax)